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**JAN 25 2007**

**OFFICE OF PETITIONS**

Brinks Hofer Gilson & Lione  
PO Box 10395  
Chicago, Illinois 60610

In re Application of  
Wauke  
Application No. 10/042,068  
Filed: January 8, 2002  
Attorney Docket NO. 9281-4240

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:  
: DECISION HOLDING PTA REQUEST  
: IN ABEYANCE UNTIL AFTER ISSUE  
: DATE  
:  
:

This decision is in response to applicants' PETITION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT timely<sup>1</sup> filed on June 16, 2005 requesting that the Office adjust the PTA at the time of the mailing of the notice of allowance to at least 836 days.

The instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

However, in addition, the Office notes that the USPTO failed to reduce for an omission pursuant to 37 CFR 1.704(c)(7). **Accordingly, the correct amount of PTA at the time of the mailing of the notice of allowance is ZERO (0) days rather than the assigned amount of four (4) days.**

Applicants agree with the reductions and addition as it relates to 37 CFR 1.702(a)(1) (24 days) and 37 CFR 1.704(b) (20 days). Applicants assert that they are entitled to at least 566 days under 37 CFR 1.703(b).

Patentees arguments are persuasive to the extent herein asserted. The Office agrees that the application will not issue within three years of either the submission of an RCE or the issuance of the patent. Accordingly, applicants will receive additional PTA for the USPTO's failure to comply with 37 CFR 1.702(b), 1.703(b). However, see *infra* as to when such PTA will be added to applicant's PTA total at the time of the mailing of the notice of allowance. In addition, the USPTO notes that applicants did not receive a reduction for the improper RCE submission on March 22, 2004. The Office notes that the RCE correction was submitted on April 16, 2004. Accordingly, the reduction pursuant to 37 CFR 1.704(c)(7) should have been for a period of 25

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<sup>1</sup>Issue fee paid on October 18, 2006.

days.<sup>2</sup> Accordingly, at the time of the notice of allowance the amount of USPTO delay is 24 days and the amount of applicant delay is 25 days.

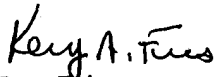
As for the request under 37 CFR 1.703(b), Patentees are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Patentee may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Petitioner is reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

After the mailing of this decision, this application will be forwarded to the Office of patent publications for a prompt issuance of the patent. The Office apologizes for any delays in this decision and notes that any delays in issuing the application within four months of the payment of the issue fee and all other requirements being satisfied will be added to the determination that is mailed with the issue notification letter.

The Office has assessed the \$200.00 fee required of this request. No additional fees are required in considering this matter.

Any questions should be directed to Kery A. Fries, Senior Legal Advisor, at 571-272-7757.



Kery Fries  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy

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<sup>2</sup>The reduction began on the day after the initial reply (3/23/04) and ended on April 16, 2004 the date of the submission of the paper correction the error.

Day : Thursday  
Date: 1/25/2007**PALM INTRANET**

Time: 10:12:56

**PTA Calculations for Application: 10/042068**

Application Filing Date:	01/08/2002	PTO Delay (PTO):	24
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	20
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	-25		

**File Contents History**

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69	07/14/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
68	07/14/2006	CASE DOCKETED TO EXAMINER IN GAU			
67	07/14/2006	NOTICE OF ALLOWABILITY			
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64	04/03/2006	MAIL EX PARTE QUAYLE ACTION (PTOL - 326)			
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9	03/31/2003	REQUIREMENT FOR RESTRICTION / ELECTION			
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7	03/07/2002	CASE DOCKETED TO EXAMINER IN GAU			
6	01/08/2002	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)			
5	01/08/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
4	02/15/2002	APPLICATION DISPATCHED FROM OIPE			
3	02/13/2002	APPLICATION IS NOW COMPLETE			
2	01/25/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
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### **EXPLANATION OF PTA CALCULATION**

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